Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN BURNS, ELLEN M. THOMAS and NAN-YAO SU[1]

Appeal No. 2000-0604
Application No. 08/483,735

HEARD: MARCH 22, 2001

Before CALVERT, FRANKFORT and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

[1] We note that appellants filed a petition under 37 CFR § 1.48(b) requesting deletion of Kevin Burns and Ellen M. Thomas as inventors on the basis that they were originally and properly included as inventors but their invention is no longer being claimed in this application (Paper No. 20, filed May 14, 1998). There is no indication in the application file that the primary examiner has considered or rendered a decision on the petition. Accordingly, Kevin Burns and Ellen M. Thomas are still listed as inventors in this application. As the ultimate decision on the petition does not appear to have any bearing on the issue before us in this appeal, we have decided this appeal in the interest of judicial efficiency and leave the petition to be decided by the examiner upon return of jurisdiction of this application to the examiner.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 3, 5, 7, 8, 10, 43-46, 49 and 50, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a method for controlling termites (claim 43 and the claims depending therefrom) and to a delivery system for controlling termites (claim 44 and the claims depending therefrom). The two independent claims on appeal read as follows:

> 43. A method for controlling termites comprising the following step:
>
> placing or mounting a delivery housing on an above or on ground target surface, the target surface extending beyond the delivery housing, the delivery housing containing a toxic termite bait material, the delivery housing having an opening defined by an edge, the edge abutting the target surface such that the delivery housing encloses part of the target surface to define an enclosed space such that substantial loss of moisture from the enclosed space is prevented, the delivery housing opening providing termite communication between the target surface and the enclosed space such that termites that may be present on the target surface have access to the toxic termite bait material in the delivery housing.
>
> 44. A delivery system for controlling termites, the delivery system comprising a delivery housing and a toxic termite bait material, the delivery housing being adapted for placement or mounting on an above or on ground target surface, the target surface extending beyond the delivery housing, the delivery housing containing the toxic termite bait material, the delivery housing having an opening defined by an edge that is adapted to abut the target surface so that the delivery housing encloses part of the

> target surface to define an enclosed space such that substantial loss of moisture from the enclosed space is prevented, the delivery housing opening providing termite communication between the target surface and the enclosed space such that termites that may be present on the target surface have access to the toxic termite bait material in the delivery housing.

The sole prior art reference of record relied upon by the examiner as evidence of obviousness is:

Burgess	3,564,750	Feb. 23, 1971

The following rejection is before us for review.

Claims 2, 3, 5, 7, 8, 10, 43-46, 49 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burgess.

Reference is made to the brief (Paper No. 28) and the final rejection and answer (Paper Nos. 25 and 29) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the Burgess reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Burgess discloses a device for protecting wooden parts of buildings against subterranean termites. The device takes the form of a baited trap, which when actuated by termites, discharges an insecticide and operates an electrical switch. According to Burgess, "[t]ypically, said device should be installed just below ground level near the wooden structure to be protected against subterranean termites" (col. 1, lines 54-56). The device comprises a frangible insecticide-containing capsule 3 attached to the lower side of a top cover 1 and enclosed by an enclosure including the top cover 1, four side covers 2 and the combination of a bottom cover 11 and bait assembly 12. Preferably, the bait assembly extends downward and outside the enclosure to provide easy accessibility to subterranean termites. A projectile 6 is held away from the capsule 3, under the tension of springs 5, by a string release trigger 7, pin release trigger 10 and alternate release trigger 9. The bait assembly 12 and the three release triggers are constructed of cellulose-containing material for consumption by termites. In the event that subterranean termites enter the device and consume any of the release triggers, the projectile 6 is released and propelled by the

biasing force of the springs 5 upward into the frangible capsule 3, thus fracturing the capsule and releasing the insecticide content onto the intruding termites. The upward movement of the projectile also severs a metal foil strip of a detector switch 8 to signal actuation of the device.

We fully understand the examiner's position in construing the bait assembly 12 of the Burgess device as a "target surface" and the enclosure including top cover 1, side covers 2 and bottom cover 11 as a delivery housing, with the bottom cover having an opening through which the bait assembly passes and which provides termite communication between the bait assembly and the enclosed space within the enclosure. The examiner concedes that Burgess does not disclose a toxic bait material contained by the housing as required by independent claims 43 and 44, but takes official notice that toxic termite baits are old and well known in the art and asserts that it would have been obvious to employ a toxic termite bait material in the frangible capsule 3, "since merely [sic: mere] substitution of one poison for another is contemplated and the function is the same and no showing of unexpected results was

made" (final rejection, page 3). Appellants have not contested this assertion by the examiner.

Appellants do, however, take issue with the examiner's characterization of the top cover 1, side covers 2 and bottom cover 11 as a delivery housing having an opening defined by an edge adapted to abut a target surface so that the housing encloses part of the target surface to define an enclosed space, as required by claims 43[2] and 44 (brief, pages 6-7). After having carefully reviewed the teachings of Burgess, we find ourselves in agreement with appellants' position for the following reasons.

The bait assembly 12 of Burgess is an integral part of the Burgess device which is connected, via the release triggers, springs and spring fasteners 4 to the side covers 2. In order to construct the Burgess device, the bait assembly 12 must first be connected to at least the side covers prior to assembling all six covers of the enclosure to form a delivery housing as construed by the examiner, thereby filling any

[2] While the language "adapted to abut" does not appear in method claim 43, the recited step of placing a delivery housing on a target surface, the delivery housing having an opening defined by an edge abutting the target surface, implicitly requires that the housing have an opening defined by an edge adapted to abut a target surface.

opening in the bottom cover 11. Consequently, we share appellants' view that the examiner's characterization of the top cover 1, four side covers 2 and bottom cover 11 as a delivery housing having an opening in the bottom cover as required by claims 43 and 44 is not well founded.

Moreover, with particular regard to method claim 43, the examiner's position that, notwithstanding the teaching by Burgess that the device should typically be installed just below ground level, placement of the entire device into the ground is not likely "because the size of the hole would have to be much larger to put the delivery housing into the ground than just the target surface" (answer, page 4), appears to us to be based upon unfounded assumptions or speculation. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In this instance,

while the examiner has proffered a rationale for placing the enclosure portion of the Burgess device above or on the ground, as required by claim 43, with only the portion of the bait assembly 12 extending from the enclosure portion located in the ground, Burgess provides no suggestion for such use of the device.

For the foregoing reasons, we shall not sustain the examiner's rejection of independent claims 43 and 44, or of claims 2, 3, 5, 8, 10, 45, 46, 49 and 50 which depend from claims 43 and 44, as being unpatentable over Burgess.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3, 5, 7, 8, 10, 43-46, 49 and 50 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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